

**REMARKS**

Applicants elect Group I, with traverse.

- Applicants respectfully traverse the Restriction Requirement as it pertains to claims 20-29.

In our case, the Examiner posits, "Inventions I and (II-IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the process as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). **In the instant case the obvious method of operating the apparatus of claims 1 and 34 is different (see method claims 20, 30 and 31).**" (emphasis added).

Applicants respectfully submit that this quoted ground for restriction in the last-quoted sentence (as read literally) is nonsensical because the Examiner has included claim 34 in the same Group I as claim 1. Alternatively, the last-quoted sentence (as best understood) is apparently a pure conclusion that "the obvious method" of using the structure of claim 1 and claim 34 is somehow "different" from one or more of method claims 20, 30, and 31.

MPEP § 806.05(h) regards when a restriction is proper for a product and process of using, and indicates that "[t]he burden is on the examiner to provide an example, but the example need not be documented." Applicants respectfully submit that the burden is on the examiner to provide reasonable examples that recite material differences (*see also* MPEP § 806.05(e)), and such has not been shown by a bare conclusory statement such as the present ground of restriction.

In addition, an obvious method of using the apparatus of claim 1 is the method of claim 20 because the only differences in wording between apparatus claim 1 and method claim 20 are

(1) the preambles, (2) the addition of the word "providing" at the beginning of the single method step in claim 20, and (3) "carrier of circuit boards" of claim 1 versus "carrier for the plurality of circuit boards" of claim 20. Therefore, the Examiner's assertion is unsupported because the claims 1 and 20 are not materially different, and it is believed that they would not be patentable over one another. See, e.g., MPEP § 802.01.

Further, an "alternative use" has not been shown by the Examiner. MPEP § 806.05(h).

For these reasons, a *prima facie* case for restriction, as defined in MPEP § 803 has not been presented and Applicants therefore respectfully request the Restriction Requirement be withdrawn regarding Groups I and II.

- Applicants also respectfully traverse the Restriction Requirement as it pertains to claims 30-33.

For reasons stated above for the traversal between Group I and Group II, the Examiners repeated statements regarding Groups II-IV are also purely conclusory. In particular the grounds of restriction state, "In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require all the details of the subcombination. **The subcombination has separate utility such as by itself for its intended purpose or in a different combination.**" (emphasis added).

Applicants respectfully submit that the just-quoted ground of rejection, repeated verbatim at ¶¶ 3-5 of the Restriction Requirement, amounts to completely conclusory language that fails to meet the Examiner's burden to provide reasonable examples that recite material differences.

In addition, an "alternative use" has not been shown by the Examiner. MPEP § 806.05(h).

MPEP § 803 makes clear that there are two criteria for a proper requirement for restriction:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is required.

MPEP § 806.04 provides illustrative examples of when it may be proper to require a restriction of claims to "independent inventions." Example B therein reads, "(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process."

The identical grounds of restriction stated for each of ¶¶ 3-5 of the Restriction Requirement (respectively addressed to Groups II and III, Groups III and IV, and Groups II and IV) do not present a *prima facie* case for restriction, as defined in MPEP § 803 and illustrated in MPEP § 806.04, because the Examiner has not provided any example of why the claims could be considered to define independent or distinct inventions, and has not shown how examination of all claims would be a serious burden. In fact, when the Examiner made a telephone call to first present the restriction and election requirements, the Examiner was unable to explain how the claims could be construed to define independent and distinct inventions.

Further, the grounds of restriction, at ¶ 6, indicates, "these inventions . . . have acquired a separate status in the art as shown by their different classification . . . ." Applicants note that, contrary to this statement, Groups II, III, and IV each are described at ¶ 1 of the Restriction Requirement as being in the same class and subclass, i.e., "class 361, subclass 686." Therefore, the restriction is inappropriate.

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For the reasons stated, Applicants respectfully request the Restriction Requirements be withdrawn regarding Groups II and III, Groups III and IV, and Groups II and IV.

- In response to ¶ 8 of the Restriction Requirement, Applicants elect choice "c" with traverse.

Since the restriction requirements of ¶¶ 1-6 are without merit, there is no basis for the election of species requirements of ¶¶ 8 and 9. MPEP § 808.01. In addition, the Examiner's citations of 35 U.S.C. § 121 in ¶¶ 8 and 9 are inappropriate since that statute applies only to divisional applications, not relevant here. Further, since the restriction requirements of ¶¶ 1-6 are without basis, the Examiner's citations of 37 C.F.R. § 1.141 are also inappropriate.

If still relevant, the Examiner is respectfully requested to explain why claims 2-4, 10-11, and 14 have been deleted from Applicants' choice of species for Group I.

- For reasons stated above, Applicants respectfully request the Restriction Requirement be withdrawn in its entirety, and all claims be presently examined.


**Request for Interview**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly **requested to call** the undersigned at the telephone number listed below.

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 10-0270.

Respectfully submitted,

  
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